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FAX # 512-823-1036

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FROM: _Marilyn Smith Dawkins_

Tel No: _512-823-0094_

Docket No. _AUS9-2000-0068US1_ Serial No. _09/583,959_ Atty: _MSD_

Applicant: _Hamzy, et al._

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| _✓_ Transmittal Letter (2 copies) | ____ Certificate of Facsimile |
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PATENT
09/583,959

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

| In re application of | : Before the Examiner: |
|---|---|
| Mark J. Hamzy, et al. | : Jungwon Chang |
| Serial No. : 09/583,959 | : Group Art Unit: 2154 |
| Confirmation Number: 2343 | |
| Filed: 05/31/2000 | : Intellectual Property Law Department |
| Title: PROTECTING RESOURCE URLs | : International Business Machines Corp. |
| FROM BEING SERVED WITHOUT A BASE | : 11400 Burnet Road |
| WEB PAGE | : Austin, Texas 78758 |

## CERTIFICATE OF FACSIMILE TRANSMISSION

I hereby certify that this correspondence is being transmitted via facsimile to the United States Patent Office at facsimile number 703-872-9306 on _3-3-05_.

Beverly Winfield

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## TRANSMITTAL OF APPELLANT'S BRIEF UNDER 37CFR 1.192(a)

Commissioner of Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Attached is Appelants'Brief, in triplicate, from a decision of the Examiner dated 10/15/2004, finally rejecting Claims 1-18.

Please charge Deposit Account No. 09-0447 in the amount of $500.00.

The Commissioner is hereby authorized to charge any additional fee which may be required or credit any overpayment to Deposit Account No. 09-0447. A duplicate copy of this document is included.

Respectfully submitted,

By Marilyn Smith Dawkins
Marilyn Smith Dawkins
Attorney for Applicants
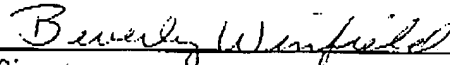Registration No. 31,140
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PAGE 2/51 * RCVD AT 3/3/2005 1:53:30 PM [Eastern Standard Time] * SVR:USPTO-EFXRF-1/0 * DNIS:8729306 * CSID:512-823-1036 * DURATION (mm-ss):12-50

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09/583,959

## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

| In re application of | : Before the Examiner: |
|---|---|
| Mark J. Hamzy, et al. | :     Jungwon Chang |
| Serial No. : 09/583,959<br>Confirmation Number: 2343<br>Filed: 05/31/2000<br>Title: PROTECTING RESOURCE URLs FROM BEING SERVED WITHOUT A BASE WEB PAGE | : Group Art Unit: 2154<br><br>: Intellectual Property Law Department<br>: International Business Machines Corp.<br>: 11400 Burnet Road<br>: Austin, Texas 78758 |

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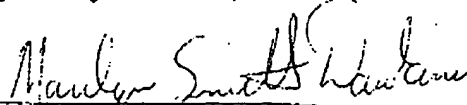### TRANSMITTAL OF APPELLANT'S BRIEF UNDER 37 CFR 1.192(a)

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Respectfully submitted,

By_____
Marilyn Smith Dawkins
Attorney for Applicants
Registration No. 31,140
512-823-0094

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**PAGE 3/51 * RCVD AT 3/3/2005 1:53:30 PM [Eastern Standard Time] * SVR:USPTO-EFXRF-1/0 * DNIS:8729306 * CSID:512-823-1036 * DURATION (mm-ss):12-50**

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Signature                          Date

Commissioner for Patents
P.O. Box 1450
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Sir:

## APPELLANT'S BRIEF UNDER 37 CFR 41.37

This is an appeal of a final rejection dated 10/15/2004 of Claims 1-18 of

application serial number 09/583,959 , filed 05/31/2000. This brief is submitted pursuant

to a Notice of Appeal filed, January 7, 2005 as required by 37 CFR 41.37.

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# I. Real Party In Interest

The real party in interest is International Business Machines Corporation, the assignee of the present Application.

# II. Related Appeals and Interferences

There are no other appeals or interferences known to appellant, appellant's representative or assignee which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

# III. Status of Claims

A. TOTAL NUMBER OF CLAIMS IN APPLICATION

There are 18 claims in this Application

B. STATUS OF ALL THE CLAIMS

1. Claims cancelled: None

2. Claims withdrawn from consideration but not cancelled: None

3. Claims pending: 1-18

4. Claims allowed: None

5. Claims rejected: 1-18

C. CLAIMS ON APPEAL

The rejected claims (claims 1-18) which form the basis of this appeal are reproduced in the attached Appendix.

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## IV. Status of Amendments

No amendments have been filed subsequent to final rejection.

## V. Summary of Claimed Subject Matter

The present invention enables the provider of valuable web content with a solution

for those that attempt to "deep link" to the valuable content without first viewing

prerequisite information. Linking directly to a resource within a Web site without

following the links from that Web site is commonly known as "deep linking" (Page 3,

lines 11-15).

The invention provides upon receiving a request for content from a client,

determining whether the requested content should be served with additional required

content (Page 8, line 27-Page 9, line 12, Page 11, lines 11-25), and whether the additional

required content has been previously sent to the client. If the request is such that the user

should also see the required content, then a different content is sent to the client, wherein

the requested content and the additional required content are combined and served.

Therefore, the client that requests deep link content benefits by not being denied access

because of deep linking, and sees all of the required information as desired by the content

producer (page 9, lines 7-8). Correspondingly, the content provider benefits by sending

combined additional prerequisite content that would not have been served if the request

had been satisfied only with the requested content of the deep link (Page 9, lines 2-11).

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When combining the resources that comprise both the requested content and those of the prerequisite content, the user will receive a different content that comprises a combination of both, or a combination of either resource modified according to certain rules (Page 9, Lines 12-25, Figures 1B, 2A, and 3-5). The combined content of the requested resource and the prerequisite resource may be produced in various ways, including by overlaying at least a portion of the prerequisite resource onto the content of the requested resource, or by merging at least a portion of the prerequisite resource into the requested resource, or by changing the resolution, the color depth, or the display size, of the combined content, or by including information about the content of the requested resource (Page 10, line. 18-Page 11, line 10, Page 12, line 14-Page 13, line 5, and Figure 4). A tracking parameter may be used to determine whether a prerequisite resource has been requested by a client previously one or more times, or if the prerequisite resource has been requested within a configurable period of time (Page 11, line 11-Page 12, line 13).

## VI.  Grounds of Rejection Presented for Review

Claims 1-18 under 35 U.S.C. 102(e) have been rejected as being anticipated by Dutta (U.S. Patent No. 6,539,424).

## VII.  Argument

Claims 1-18 stand rejected under 35 U.S.C. 102(e) as being anticipated by Dutta. That rejection is respectfully traversed. In essence, Dutta does not teach a different

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resource having a **combination** of the content of the requested resource and at least a portion of at least one prerequisite resource.

### Claims 1, 14 and 18

With respect to claims 1, 14, and 18, the Office Action states,

> "...sending a different resource (404, fig. 4, i.e., home page, index.html) having a content combining the requested resource content (312, fig. 3; i.e., requested resource) and at least a portion of content of at least one prerequisite resource (404, fig. 4; col. 6, lines 3-16) if the requested resource requires a prerequisite resource (402, fig. 4; col. 5, lines 45-49)."

The rejection is overcome because Dutta does not teach the claim element "sending a different resource having a content **combining** the requested resource **content** and at least a portion of content of at least one prerequisite resource if the requested resource requires the prerequisite resource."

Dutta teaches that a resource is sent along with information as to **how to get** the requested resource (Col. 2, line 62-Col. 3, line 2). Dutta does not combine the content of the requested resource with the different resource. Dutta merely sends a resource page, such as a home page, with information on how to get the user's desired (requested) page (column 6, lines 38-51). Dutta teaches that the request for the deep linked content is rerouted to the content provider's home page, with additional links that the user should follow in order for the user to get to the desired deep link (Col. 2, lines 62-Col. 3, line 2), and the home page is not combined with the requested page.

The Examiner's argument that Dutta teaches "having a content combining the requested resource content (312, fig 3; i.e., requested resource) and at least a portion of content of at least one prerequisite resource (404, fig 4; col 6, lines 3-16)" is respectfully traversed. Dutta teaches the hyperlink structure of the Web pages of a content producer (Col. 4, lines 60-61, Fig. 3:300, 312), and deep links that bypass the home page index

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(Col. 5, lines 16-22), and that "the server sends back to the client the home page with the cookie as shown in FIG. 5C... in response to a request for a deeply linked page; a home page, or other given page, is sent to the client. The server also sends information to the user indicating that the user is interested in a given page which the user attempted to deep link to, and an appended note instructing the user **how to access** the page desired by the user... In another embodiment, the server could merely send the user back to the home page." (Col. 6, lines 1-18, Fig 4:404, 405, 406) (emphasis added). Nowhere does Dutta teach "combining" the requested resource content and any other content, much less combining it with "at least a portion of content of at least one prerequisite resource" as claimed by Applicants.

Applicants have maintained their position regarding Dutta's lack in teaching as argued above. However, in the Final Office Action, the Examiner traversed Applicants' remarks in Applicants' response to the Office Action. In the Final Action, the Examiner stated:

> "In the remarks, applicant argued in substance that
> (1)    The following element, found in each independent claim, is not found in Dutta: 'different resource has a content combining the requested resource content'. Dutta teaches that a different resource (e.g., a home page) is sent along with information as to how to get the requested resource. Dutta does not combine the content of the requested resource with the different resource.
> 18.          Examiner respectfully traverses applicant's remarks. As to point (1), in response to applicant's argument, examiner disagrees since independent claims 1,14, and 18 are not clearly directed to method and means for how to combine the requested resource content with at least a portion of another resource content. Based on the claim language in claims 13 and 17, 'combining the requested resource content with at least a portion of another resource content wherein the requested resource can be reached by following links from the another resource

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> content (i.e.. home page)'. Dutta clearly
> teaches that the requested resource (i.e.,
> Jaws.html, 312, fig. 3; 403, fig. 4) can be
> reached by following links (i.e.,
> movies.html, 310, fig. 3; 405, fig. 4) from
> the another resource content (i.e., home
> page; index.html, 301, fig. 3; 401, fig. 4)."

Applicants submit that independent claims 1, 14, and 18 are specifically directed to "in a server data processing system" with the limitation "sending a different resource having a content combining the requested resource content and at least a portion of content of at least one prerequisite resource..." Applicants submit that claims 1, 14, and 18 are clear, specific, and are fully supported by the specification, where Applicants teach a multitude of methods for combining the requested resource and at least a portion of content of at least one prerequisite resource. Applicants' specification teach that the "different resource may be either a combination of the resource along with the prerequisite resource, or the different resource may be the requested resource that has been modified to contain any prerequisite information" (Page 11, lines 1-3). Furthermore, "[t]he requested resource can be modified in several ways" (Page 12, line 14). Applicants' specification goes further to give individual examples of various algorithms to combine the requested resource with the prerequisite resource: "[i]n one embodiment, the text of the prerequisite resources are overlaid onto the content of the requested resource." (Page 13, lines 14-15), "[i]n another embodiment, the requested resource is reduced in sized or scaled down or represented as and icon and merged into the prerequisite resource." (Page 13, lines 18-20), "[i]n an alternate embodiment, each prerequisite resource can be reduced in size and merged with the content of the requested resource" (Page 13, lines 22-24), "[i]n yet another embodiment, the requested resource can be sent using a lesser quality resolution such as a smaller resolution, or using a lesser color depth" (Page 14, lines 1-2), "[i]n another embodiment, the prerequisite resource may be served by modifying the requested resource... One directory may contain the requested resource ... and another directory may contain the requested resource as modified as described above in combination with

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the prerequisite resource" (Page 14, lines 9-15). Thus, the rejection in the Final Office Action asserting that "independent claims 1, 14, and 18 are not clearly directed to method and means for how to combine the requested resource with at least a portion of another resource content" is respectfully traversed and overcome.

Furthermore, the Final Office Action noted suggesting that independent claims 1, 14, and 18 are somehow necessarily linked to independent claims 13 and 17, and that claims 1, 14, and 18 somehow should have the similar claim limitations as independent claims 13 and 17. Applicants submit that independent claims 1, 14 and 18 are directed to "in a server data processing system" and independent claims 13 and 17 are directed to "in a client data processing system". Thus, the elements of independent claims 1, 14, and 18 are separate and distinct from those of independent claims 13 and 17, and that claims 1, 14, and 18 are indeed clearly directed.

### Claims 2-8

With respect to claims 2-8, the rejection is overcome because Dutta does not teach Applicants' claim limitations. As argued above with respect to claim 1, Dutta does not teach the limitations of claim 1, particularly Dutta does not teach "sending a different resource having a content **combining** the requested resource **content** and at least a portion of content of at least one prerequisite resource if the requested resource requires the prerequisite resource." Dependent claims 2-8 are dependent from claim 1, and incorporate all the limitations of independent claim 1. Accordingly, the rejection of claims 2-8 should be reversed.

### Claim 9

With respect to claim 9, the rejection is overcome, first, because as discussed earlier with respect to claim 1, in particular, Dutta does not teach "sending a different resource having a content **combining** the requested resource **content** and at least a portion of content of at least one prerequisite resource if the requested resource requires the

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prerequisite resource." Dependent claim 9 is dependent from claim 1, and incorporates the limitations of independent claim 1. Furthermore, the rejection is overcome because Dutta teaches away from Applicants' invention. The rejection asserted that "Dutta further discloses modification comprises merging the content of the prerequisite resource with the content of the requested resource (Col. 6, lines 39-44, Col. 4, lines 10-23, Col. 6, lines 6-10 and 39-44, and Col. 8, lines 8-16)." Dutta teaches "[i]f a user attempts to go to a deep link within a content producer's server, then the user is sent to the content producer's home page with information on how to get to the user's desired page from the home page. The user is also sent a cookie with permission to get to the next child page and/or to the desired page" (Col 6, lines 39-44). It is clear that Dutta does not teach "merging" as asserted in the Final Office Action, and instead Dutta teaches away from Applicants' invention by sending to the user the content producer's home page and a cookie, instead of sending "the content of the different resource [that] comprises overlaying at least a portion of the prerequisite resource on the content of the requested resource" as claimed by Applicants. Furthermore, Dutta teaches "...the deep hyperlink is rerouted...to the content producer's home page" (see Col. 4, lines 10-23), "in response to a request for a deeply linked page; a home page, or other given page, is sent to the client" (Col. 6, lines 6-10), thus teaching away from Applicants' claimed invention. The Final Office Action also cited elements of Dutta's claim 1, but this also teaches away from Applicants' claimed invention. Dutta teaches "means for sending a higher level page, in response to the request, along with an indication of a next page having a next sequential link to subsequently reach the desired page; and means for repeatedly sending the next page, in response to each request for the next page from the client, along with an indication of a subsequent page having a subsequent link for the client to follow, until the desired page has been sent." (Dutta, Claim 1 at Col. 8, lines 8-16). Dutta clearly teaches away from Applicants' claimed invention by sending the contents of the home page instead of sending different content that "comprises overlaying at least a portion of the prerequisite

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resource on the content of the requested resource", as claimed by Applicants. Thus, the rejection of claim 9 is overcome.

### Claim 10

With respect to claim 10, the Examiner rejected dependent claim 10 using the same rationale as for claim 9. The rejection is overcome because Dutta does not teach Applicants' claim limitations, as discussed earlier with respect to claim 1, and to claim 9, Dutta does not teach "sending a different resource having a content **combining** the requested resource **content** and at least a portion of content of at least one prerequisite resource if the requested resource requires the prerequisite resource." Dependent claim 10 is dependent from claim 1, and incorporates all the limitations of independent claim 1. Applicants submit that Dutta also does not teach "merging the content of the prerequisite resource with content of the requested resource" as claimed by Applicants. Dutta clearly teaches away from Applicants' claimed invention by sending the contents of the home page without sending also the contents of the requested resource; and instead of sending different content that comprises "merging the content of the prerequisite resource with content of the requested resource" as claimed by Applicants. Thus, the rejection of claim 10 is overcome.

### Claims 11 and 12

With respect to claims 11 and 12, the rejection is overcome. Dutta does not teach Applicants' claim limitations, as discussed earlier with respect to claim 1. Dutta does not teach the limitations of claim 1. Dependent claims 11 and 12 are dependent from claim 1, and incorporate the limitations of independent claim 1. Furthermore, the Examiner rejected claims 11 and 12, stating that Dutta teaches Applicants' claimed invention in column 7, lines 4-20 asserting that a "web publisher can modify the web pages using the program code." At the cited location in the reference, Dutta teaches "a method, system, or article of manufacture using standard programming and/or engineering techniques to

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produce software, firmware, hardware, or any combination thereof." (Col. 7, lines 4-7). Nowhere in the cited section of the reference or anywhere in Dutta is there so much as a glimpse of Applicants' claimed invention. In addition, the rejection is overcome because the reference does not teach any program code "changing a resolution to a lesser quality" or "changing color depth" as per Applicants' limitations of claims 11 and 12.

### Claims 13 and 17

The rejection is overcome because Dutta does not teach the element of representative claim 13, "receiving a different resource than the requested resource if the requested resource was a deep hyperlink wherein the different resource has a content combining the requested resource content with at least a portion of another resource content wherein the requested resource can be reached by following links from the another resource content" and similar elements in claim 17. Dutta teaches that "[i]f the content provider receives a request for a Web page that is a deep hyperlink into the content provider's Web site, the content provider reroutes the request to the content provider's home page. In addition, the content provider displays to the user the next link or sequence of links that the user should follow in order for the user to get to the desired deep link." (Col. 2, line 62-Col. 3, line 2). In Dutta, information is displayed to the user as to how to get the requested resource (Col. 2, line 62-Col. 3, line 2), thus, Dutta does not combine the content of the requested resource with the different resource. The rejection in the Final Office Action argues that Dutta "has a content combining the requested resource content (312, fig 3; i.e., requested resource) and at least a portion of content of at least one prerequisite resource (404, fig 4; col 6, lines 3-16)" is not well founded. Dutta in Figure 3:312 merely teaches the hyperlink structure of the Web pages of a content producer (Col. 4, lines 60-61), and deep links that bypass the home page index (Col. 5, lines 16-22). Dutta teaches "the server sends back to the client the home page with the cookie as shown in FIG. 5C... in response to a request for a deeply linked page; a home page, or other given page, is sent to the client... The server also sends information to the user indicating

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that the user is interested in a given page which the user attempted to deep link to, and an appended note instructing the user how to access the page desired by the user... In another embodiment, the server could merely send the user back to the home page." (Col. 6, lines 1-18, Fig. 4:404, 405, 406). Nowhere does Dutta teach "combining" the content of the requested resource with any other content, much less combining it with "at least a portion of content of at least one prerequisite resource" as claimed by Applicants.

In Applicants' claims 13 and 17, the "different resource" contains a combination of content of the requested resource and at least a portion of "another resource". Which "another resource" is used in the combination of content is defined in the claim to be that resource from which the requested resource could be reached by following links from it. As such, the "wherein" clause merely identifies the "another resource".
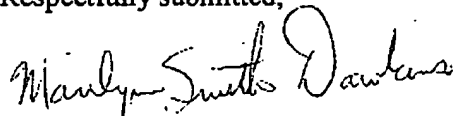
### Claims 15-16

With respect to claims 15-16, the rejection is overcome because Dutta does not teach Applicants' claim limitations. As discussed earlier with respect to claims 1, 14 and 18, Dutta does not teach the limitations of claim 14. Dependent claims 15-16 are dependent from claim 14 and incorporate the limitations of claim 14. Accordingly, the rejection of claims 15-16 should be reversed.

### CONCLUSION

It is therefore respectfully requested that the Examiner's rejection of Claims 1-18 under 35 USC Section 102(e) be reversed. It is respectfully submitted that the claims remaining in the Application are patentable under 35 USC and allowance of these claims to Appellants is respectfully requested.

Respectfully submitted,

Marilyn Smith Dawkins
Attorney for Applicants
Registration No. 31,140
(512) 823-0094

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# VIII. APPENDIX

Claims on Appeal:

1.      A method, in a server data processing system, for servicing a request for a resource requested by a client data processing system, comprising:

     receiving the request for the resource from a requester;

     determining if the resource requires at least one prerequisite resource, and if the at least one prerequisite resource has been previously requested by the requester; and

     sending a different resource having a content combining the requested resource content and at least a portion of content of at least one prerequisite resource if the requested resource requires the prerequisite resource.

2.      The method of claim 1 further comprising keeping track of each request made for the at least one prerequisite resource for each requester within a tracking parameter.

3.      The method of claim 2 wherein the tracking parameter is for a predetermined amount of time.

4.      The method of claim 3 wherein the predetermined amount of time is a configurable amount of time.

5.      The method of claim 2 wherein the tracking parameter is for a predetermined number of requests for the requested resource.

6.    The method of claim 2 further comprising determining if a previous request has been made by the requester for the prerequisite resource within the tracking parameter if the requested resource requires a prerequisite resource.

7.    The method of claim 6 wherein the different resource is sent if the resource requires a prerequisite resource and if it is determined that any previous request by the requester for the prerequisite resource has not been made within the tracking parameter.

8.    The method of claim 1 wherein the determining step further comprises determining which at least one resource is the at least one prerequisite resource.

9.    The method of claim 1 wherein the content of the different resource comprises overlaying at least a portion of the prerequisite resource on the content of the requested resource.

10.    The method of claim 1 wherein the content of the different resource comprises merging the content of the prerequisite resource with the content of the requested resource.

11.    The method of claim 1 wherein the content of the different resource comprises changing a resolution of the requested resource to a lesser quality.

12.    The method of claim 1 wherein the content of the different resource comprises changing color depth.

13.    A method, in a client data processing system, for receiving a resource in response to a request to a server data processing system, comprising:

sending the request; and

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receiving a different resource than the requested resource if the requested resource was a deep hyperlink wherein the different resource has a content combining the requested resource content with at least a portion of another resource content wherein the requested resource can be reached by following links from the another resource content.

14.    A server data processing system having means for servicing a request for a resource requested by a client data processing system, the server data processing system comprising;

means for receiving the request for the resource from a requester;

means for determining if the resource requires at least one prerequisite resource, and if the at least one prerequisite resource has been previously requested by the requester; and

means for sending a different resource having a content combining the requested resource content and at least a portion of content of at least one prerequisite resource if the requested resource requires the prerequisite resource.

15.    The data processing system of claim 14 further comprising means for keeping track of each request made for the at least one prerequisite resource for each requester within a tracking parameter.

16.    The data processing system of claim 15 further comprising means for determining if a previous request has been made by the requester for the prerequisite resource within the tracking parameter if the requested resource requires a prerequisite resource.

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17.    A client data processing system, having means for receiving a resource in response to a request to a request to a server data processing system, the client data processing system comprising;

means for sending the request; and

means for receiving a different resource than the requested resource if the requested resource was a deep hyperlink wherein the different resource has a content combining the requested resource content with at least a portion of another resource content wherein the requested resource can be reached by following links from the another resource content.

18.    A program, having computer readable program code means, on a computer usable medium, at a server data processing system, for servicing a request for a resource requested by a client data processing system, comprising;

instruction means enabling receipt of the request for the resource from a requester;

instruction means causing a determination of whether the resource requires at least one prerequisite resource, and if the at least one prerequisite resource has been previously requested by the requester; and

instruction means enabling a sending of a different resource having a content combining the requested resource content and at least a portion of content of at least one prerequisite resource if the requested resource requires the prerequisite resource.

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